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No. 88-1936

In The

# Supreme Court of the United States

October Term, 1988

NEWELL COMPANIES, INC.,

*Petitioner,*

vs.

KENNEY MANUFACTURING COMPANY,

*Respondent.*

**Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit**

## RESPONDENT'S BRIEF IN OPPOSITION TO PETITION

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July 14, 1989

## COUNTERSTATEMENT OF QUESTION PRESENTED

In a patent infringement action in which there were no disputed issues of material fact, should this Court review a decision of the Federal Circuit Court of Appeals affirming a directed verdict that the patent in suit was not valid because the subject matter as a whole would have been obvious to a person of ordinary skill in the pertinent art.

## STATEMENT PURSUANT TO COURT RULE 28.1

Pursuant to Court Rule 28.1, the respondent Kenney Manufacturing Company states that it is not publicly held and is not an affiliate of any publicly held company.

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## RESPONDENT'S BRIEF IN OPPOSITION TO PETITION

## STATEMENT OF THE CASE

Two experienced District Courts have separately concluded that the window shade claimed in United States Patent 4,006,770 ("the '770 patent") would have been obvious to one of ordinary skill in the art.[1] The panel majority decision of the

[1] In addition to the District Court below, the United States District Court for the Eastern District of Illinois, on September 19, 1985, in *Newell Companies, Inc.* v. *Clopay Corporation*, No. 78 C 329 (E.D.Ill. September 19, 1985), granted Clopay's motion for summary judgment that the '770 patent is invalid for obviousness. The court noted that it had independently reached its obviousness conclusion

Federal Circuit Court of Appeals affirmed one of these decisions (the other was not appealed). And the '770 patent is related to a patent application which the Court of Customs and Patent Appeals found not to be allowable for the same reason. *In re Corcoran*, 640 F.2d 1331, 1334 (CCPA 1981).[2]

This Petition raises no issue not properly dealt with by the District Court below and by the Federal Circuit and should be denied. As discussed below, contrary to the implication in the Petition, the panel majority did not in any way diminish the jury's fact finding role, did not "mandate" special interrogatories, and did not in any other way change the traditional role of the jury in patent or other cases. The panel majority decision is not "a controversial, sweeping, authority-usurping landmark decision" (P 7-8) and no amount of rhetoric can make it so.

**A. The District Court Proceedings**

1. *The Trial*

Newell Companies Inc. ("Newell") commenced this action on June 25, 1982 in the United States District Court for Rhode Island, charging infringement by Kenney Manufacturing Co. ("Kenney") of claims 1, 2, 6 and 7 of the '770 patent, and demanding a jury trial.

The '770 patent describes and claims a particular window shade with a vinyl shade material which contains invisible slit lines. The material is mounted on a conventional telescoping metal roller. The customer holds the shade up to a window, peels the vinyl along one of the slit lines to match the width of the window, adjusts the telescoping roller to the proper size and installs the shade.

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prior to the decision by Chief Judge Boyle in the present action. That decision was withdrawn upon agreement of the parties but a copy is in the Supplemental Appendix on the Appeal (SA 974-999).

In this Opposition "JA" refers to the Joint Appendix below, "SA" refers to the Supplemental Appendix on the Appeal, "P" refers to the Petition, and "A" refers to the Appendix to the Petition.

[2] The Court of Customs and Patent Appeals was one of the predecessor courts to the Federal Circuit Court of Appeals.

Kenney denied infringement and asserted that the '770 patent was invalid and that it had been procured by fraud, because Newell did not inform the Patent Office about the most pertinent prior art — the recently developed Corcoran slit vinyl shade material used by Ferguson, the patentee, in making his patented shade.

At trial on the issues of validity and infringement, Newell offered the testimony of the patentee Ferguson about how he made his shade. That testimony was noteworthy for Ferguson's admissions (1) that his work was not responsible for the commercial success of Newell's patented shade, and (2) that it would have been obvious to one of ordinary skill in the art to use the prior art Corcoran shade material on an adjustable roller (JA 177, 173).

At the close of Newell's case, and at the close of all the evidence, Kenney moved for directed verdicts of invalidity and noninfringement (JA 430-39). The Court reserved decision (JA 591) and charged the jury.

The Petition contends that the jury was properly instructed. This was not so.[3] On the contrary, the jury was, in effect, told to ignore the Corcoran prior art work. Although Kenney had dropped its defense that the '770 patent was invalid under 35 U.S.C. § 102 because it was anticipated by Corcoran's adjustable shade, the Court, nevertheless, explained the basis of that defense to the jury, including Corcoran's work (JA 687-88), and then specifically directed the jury to find the '770 patent novel (JA 689). With respect to the Corcoran work, the jury was instructed:

> "The defendant claims that plaintiff's do-it-yourself window shade is not novel. In support of this claim it alleges that the window shade was actually invented by Sean Corcoran, a citizen of Ireland, in the early 1970's. It

[3] While the jury instructions are not directly the subject of the Petition, the dissenting opinion of the panel minority and the Petition proclaim that the jury instructions were proper, and that the jury verdict was not in any way tainted by incorrect instructions (e.g., P 5, 22). We believe it appropriate, therefore, to point out some of the ways that the jury instructions were fundamentally flawed.

> further alleges that Sean Corcoran offered his product for sale through publications in the United States and Europe before the plaintiff's patent was applied for ..." (JA 687).

After this explanation, the Court directed the jury to find that the '770 patent was not invalid because of anticipation (lack of novelty):

> "I will direct you as a matter of law that upon my review of the circumstances, your answer to this question must be no." (JA 689).

And although Kenney also withdrew its fraud defense,[4] the Court charged the jury:

> "There is no issue in this matter with respect to whether or not there was fraud. You may not consider any evidence with respect to this issue." (JA 669)

However, the evidence which was the subject of this charge—the Corcoran shade — was also the heart of Kenney's obviousness defense under 35 U.S.C. § 103.

By contrast, the jury was never instructed that it should consider the Corcoran prior art shade on the issue of obviousness under 35 U.S.C. § 103. Thus, the only instructions relating specifically to Corcoran, the most pertinent prior art, were to the effect that Corcoran's work should be disregarded.

The jury returned general verdicts that Kenney had not sustained its burden to prove that any claim of the '770 patent was obvious, and that Newell had proved that Kenney infringed claim 1 of the '770 patent.

2. *The Grant of Directed Verdict*

On April 4, 1985, Chief Judge Boyle issued a comprehensive 48 page opinion granting Kenney's reserved motions for directed verdicts.[5] After articulating the applicable

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[4] Kenney's trial counsel withdrew the fraud defense because he elected to try that issue in connection with Kenney's antitrust counterclaim.

[5] The procedure of ruling on the directed verdict motion after the jury verdict and entering judgment thereon is in accordance with the law of the First Circuit as well as other Circuits. See *Norton* v. *Snapper Power Equipment*, 806 F.2d 1545, 1547 (11 Cir. 1987); *Klein* v. *District of Columbia*, 409 F.2d 164, 167n.3 (D.C.Cir. 1969).

legal requirements for directing a verdict, standards which the Petition concedes are correct (P 6), the Court's opinion carefully reviewed the law relating to obviousness.[6]

Judge Boyle then reviewed in detail the evidence relating to obviousness, including the prior art, the level of ordinary skill in the art, the differences between the prior art and the claimed invention and the commercial success of Newell's shade (A 82a-92a). Judge Boyle noted:

> "There was no evidence that others skilled in the art tried and failed to find a solution to the problems preventing in-home fitting of window shades once the Corcoran material was introduced." (A 87a)

Judge Boyle also dealt in detail with the issue of infringement, including an extensive analysis of the claim language and prosecution history of the '770 patent, the prior art, and the amendments submitted and arguments made by Newell to overcome the Examiner's prior art rejections.

He concluded:

> "reasonable jurors could not conclude that claims 1, 2, 6, or 7 of the 770 patent are valid [and] ... no reasonable jury could conclude that claims 1, 2, 6 or 7 of the 770 patent were infringed". (A 67a-68a)[7]

After entry of Judgment on April 4, 1985, Kenney timely moved (1) for a determination that the case was exceptional and for an award of reasonable attorney fees, and (2) for an order conditionally granting a new trial in the event the Judgment were reversed on appeal. On May 23, 1985, Judge

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[6] The District Court stated that it must (1) consider all the evidence; (2) in a light most favorable to the non-moving party; (3) drawing reasonable inferences favorable to the non-moving party; (4) without determining the credibility of witnesses; and (5) without substituting its judgment for that of the jury on conflicting evidence.

[7] The Petition's suggestion that Judge Boyle did not apply the proper standard (P 6) is belied by the specific language of the court's conclusion as well as by the rest of the 48 page comprehensive opinion.

Boyle denied Kenney's motion for attorney fees, and on November 22, 1985 he denied Kenney's motion for an order conditionally granting a new trial. (SA 970-73,1000-01)

Newell appealed the grant of directed verdicts. Kenney appealed the denial of its motion for award of attorney fees and the denial of its conditional motion for grant of a new trial.

**B. The Court Of Appeals Decision**

On December 29, 1988, a majority of a panel of the Federal Circuit Court of Appeals affirmed Judge Boyle's grant of directed verdict that the '770 patent was invalid for obviousness. The panel did not consider the directed verdict of noninfringement or the denial of Kenney's conditional motion for a new trial.

The panel majority began its analysis of Judge Boyle's decision by noting that "Newell does not challenge the trial court's statement of the facts underlying the trial court's obviousness conclusion except in an immaterial detail." (A 7a)

The panel majority also noted, however, that: "To the extent, if any, that Newell disputes any of the material facts relied on by the court, we conclude that no reasonable jury could resolve the underlying factual disputes on this record other than as stated by the trial judge. No error in overturning a material fact has been explicitly argued or shown." (A 23a n.17)

The panel majority also noted with respect to Judge Boyle's analysis, "No fault can be found in the legal propositions on which the court relied or in the court's method of analysis, and Newell asserts none." (A 18a)

The panel majority carefully reviewed Judge Boyle's decision on obviousness, including the underlying facts relied on by Judge Boyle. The majority then affirmed that decision.

The panel minority dissented. The dissent relied largely on cases decided before this Court's decision in *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966), and on District Court and Courts

of Appeals cases involving disputed issues of material fact, not, as here, cases in which the material facts were undisputed.

The minority opinion also focused on purported deficiencies in the prior art that were completely solved by the prior art Corcoran material. Corcoran's prior art shade material did not become available until the early 1970's. It follows, as Judge Boyle recognized and the Court of Appeals affirmed, that whatever happened or did not happen before that time is irrelevant. As Judge Boyle noted there was no evidence of any unsuccessful attempt after the Corcoran material became available (*infra* at p. 13).

## REASONS FOR DENYING THE WRIT AND SUMMARY OF ARGUMENT

Nothing in this case warrants review on certiorari. There are no special or important reasons why this Court should give petitioner another hearing on matters already considered and correctly decided below, as well as in another District Court. The detailed District Court opinion and the comprehensive Court of Appeals majority opinion dealt with and rejected essentially the same arguments Newell presents in its Petition.

Judge Boyle's decision and the Federal Circuit's affirmance are sensible, fair and fully in accord with the opinions of this Court and with decisions of other courts.

All the evidence, including the patentee's own admissions set forth by the majority opinion, establish that once Corcoran's prior art adjustable vinyl window shade material was available, anyone who considered it recognized that the material should be mounted on telescoping rollers just as the patentee Ferguson did. It is not surprising, therefore, that Ferguson testified that the Corcoran material was the "heart" of his product (JA 178). As Judge Boyle noted, there was no evidence that, after the Corcoran prior art material was introduced, anyone skilled in the art failed to solve any problem of making a window shade which could be adjusted at home without tools (A 87a).

Newell's arguments in the Petition, and the opinion of the panel minority on which it relies, are based on a faulty reading

of the record, and on a distortion of the decisions of the Federal Circuit and of this Court.

The position that Newell asserts in this case would effectively eliminate the use of summary judgment involving the obviousness of a patent and would preclude a District Court from granting a directed verdict or a judgment N.O.V. on that issue even when there are no disputed issues of material fact.

## ARGUMENT

### The Court of Appeals Decision Is Manifestly Correct

1. *There Has Been No Violation Of The Seventh Amendment*

The Petition argues strenuously that Newell's Seventh Amendment rights have been violated. Newell argues that, in effect, a case can never be taken from the jury even when the facts are undisputed. This Court laid that unsound contention to rest many years ago. *Galloway* v. *United States*, 319 U.S. 372, 389 (1943).

The District Court has the power, indeed the obligation, to take a case away from the jury when appropriate. To do so does not violate the Seventh Amendment.

As this Court explained in *Hepner* v. *United States*, 213 U.S. 103, 115 (1909):

> "The defendant was, of course, entitled to have a jury summoned in this case, but that right was subject to the condition, fundamental in the conduct of civil actions, that the court may withdraw a case from the jury and direct a verdict, according to the law if the evidence is uncontradicted and raises only a question of law."

See also *Tull* v. *United States*, 481 U.S. 412 (1987).

This is so whether the issue is before the Court on a motion for summary judgment, for directed verdict (as here) or for judgment notwithstanding the verdict. All of these motions are governed by the same standard. *Anderson* v. *Liberty Lobby*,

*Inc.*, 477 U.S. 242, 251 (1986). "In essence, though, the inquiry under each is the same: whether the evidence presents a sufficient disagreement to require submission to a jury or whether it is so one-sided that one party must prevail as a matter of law." 477 U.S. at 251-52. See also *Celotex Corp.* v. *Catrett*, 477 U.S. 317 (1986); and *Matsushita Elec. Industrial Co.* v. *Zenith Radio*, 475 U.S. 574 (1986).

This Court has repeatedly emphasized the propriety and desirability of taking a case from the jury where appropriate. E.g., *Improvement Company* v. *Munson*, 14 Wall 442, 448 (U.S. 1871); *Herron* v. *Southern Pacific Co.*, 283 U.S. 91, 95 (1931). The Petition's contention, therefore, that the Federal Circuit has treated "a jury's findings of fact differently than any other court must" (P 12) is simply not so.

Patent cases are not unique and are appropriate subjects for summary judgment, directed verdicts or judgment N.O.V. Thus, for example, a motion for judgment N.O.V. was affirmed by the Federal Circuit in *Connell* v. *Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed.Cir. 1983). And, summary judgments have been affirmed by the Federal Circuit in *Constant* v. *Advanced Micro-Devices, Inc.*, 848 F.2d 1561 (Fed.Cir. 1988); *Union Carbide Corp.* v. *American Can Co.*, 724 F.2d 1567 (Fed.Cir. 1984); *Chore-Time Equipment* v. *Cumberland Corp.*, 713 F.2d 774 (Fed.Cir. 1983); *Barmag Barmer Maschinenfabrik Ag* v. *Murata Mach., Ltd.*, 731 F.2d 831, 834-35 (Fed.Cir. 1984); *Avia Group Intern., Inc.* v. *L.A. Gear California*, 853 F.2d 1557 (Fed.Cir. 1988). As the Federal Circuit in *Brenner* v. *United States*, 773 F.2d 306, 307 (Fed.Cir. 1985), explained:

> "'[s]ummary judgment is as appropriate in a patent case as in any other' where no genuine issue of material fact is present and the movant is entitled to judgment as a matter of law."

2. *Obviousness Is A Matter Of Law*

The Petition seems to suggest that the question of whether obviousness is a matter of law remains unsettled. This is simply not so.

As this Court has made plain, obviousness is an issue of law. "[T]he ultimate question of patent validity is one of law." *Graham* v. *John Deere Co.*, 383 U.S. 1, 17 (1966); *Anderson's-Black Rock* v. *Pavement Co.*, 396 U.S. 57 (1969).

The Petition also seems to suggest that the Federal Circuit itself is divided on this point (P 10). Again, that is not so.[8] Pertinent here is the *Panduit* series of cases. In *Dennison Mfg. Co.* v. *Panduit Corp.*, 475 U.S. 809, 811 (1986), this Court remanded a case to the Federal Circuit to seek its "informed opinion on the complex issue of the degree to which the obviousness determination is one of fact." 475 U.S. at 811.

On remand, the Federal Circuit unanimously affirmed that the determination of obviousness is a matter of law. *Panduit Corp.* v. *Dennison Mfg. Co.* [*II*], 810 F.2d 1561, 1566-67 (Fed.Cir. 1987). As the Federal Circuit explained:

> "The Supreme Court, the regional Circuit Courts of Appeals, and this court have consistently treated the question as one of law. "*Graham's* statement, 'the ultimate question of patent validity is one of law', has been widely interpreted as meaning that one answering the § 103 question is drawing a legal conclusion....
>
> * * *
>
> "Scholars who have dealt with the question unanimously view it as one of law."

The Federal Circuit has also confirmed that the issue of obviousness is a question of law regardless of whether the Court or the jury is the trier of fact. *Structural Rubber Products* v. *Park Rubber*, 749 F.2d 707, 718 (Fed.Cir. 1984). See also *Medtronic, Inc.* v. *Intermedics Inc.*, 799 F.2d 734, 738, 743 (Fed.Cir. 1986):[9]

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[8] One dissent does not mean that the Circuit is split, particularly given that the court denied a request for hearing en banc.

[9] Newell's arguments about a purported split in Circuit decisions before the formation of the Federal Circuit are interesting but irrelevant (P 19-20). The Federal Circuit has exclusive jurisdiction over patent appeals and, as discussed above, there is no split on this issue.

> "Obviousness is a question of law. In reviewing a District Court's refusal to grant JNOV, it is the duty of this court to be satisfied that the law has been correctly applied to the facts found. *Structural Rubber Products*, 749 F.2d at 719, 223 USPQ at 1273; *Railroad Dynamics, Inc.*, 727 F.2d at 1512, 220 USPQ at 936."

3. *The Court of Appeals Applied The Proper Standard Of Review*

The Federal Circuit has consistently and properly held that jury decisions on the legal issue of obviousness must be the subject of independent judicial review, e.g., *Sjolund* v. *Musland*, 847 F.2d 1573, 1580 (Fed.Cir. 1988); *White* v. *Jeffrey Min. Machinery Co.*, 723 F.2d 1553, 1558 (Fed.Cir. 1983). Even in *Connell* v. *Sears, Roebuck & Co.*, 722 F.2d 1542, 1550 (Fed.Cir. 1983), cited by the minority dissent, Chief Judge Markey relied on "[o]ur independent consideration of the record" to affirm a grant of judgment N.O.V. This approach is consistent with that followed by other Circuit Courts of Appeal before the Federal Circuit came into existence. In *Control Components, Inc.* v. *Valtek, Inc.* 609 F.2d 763, 768 (5 Cir. 1980), for example, the Court of Appeals referred to its "independent review" in considering the jury's findings on validity. See also *Brunswick Corp.* v. *Champion Spark Plug Co.*, 689 F.2d 740 (7 Cir. 1982); *Bentley* v. *Sunset House Distributing Corp.*, 359 F.2d 140 (9 Cir. 1966); *Swofford* v. *B & W, Inc.*, 395 F.2d 362 (5 Cir. 1968); *Pederson* v. *Stewart-Warner Corp.*, 536 F.2d 1179 (7 Cir. 1976); *Allen Industries, Inc.* v. *National Sponge Cushion Co.*, 403 F.2d 717 (3 Cir. 1968).

Similarly, the Federal Circuit has held that independent review is the standard for review of summary judgment on the obviousness issue, e.g., *Union Carbide Corp.* v. *American Can Co.*, 724 F.2d 1567, 1573 (Fed.Cir. 1984).

As the Federal Circuit in *Railroad Dynamics, Inc.* v. *A. Stucki Co.*, 727 F.2d 1506, 1513, 1515 (Fed.Cir. 1984), explained in reviewing a jury verdict:

> "Given the facts supported by substantial evidence, we are certainly at liberty, as is the trial court, to say that the

jury committed an error of law in reaching its conclusion on obviousness when those facts will not in law support the conclusion....

* * *

"There is no question that the judge must remain the ultimate arbiter on the question of obviousness."

And as the Federal Circuit explained in *Structural Rubber Products* v. *Pack Rubber*, 749 F2d 707, 718-19 (Fed.Cir. 1984):

"The introduction of a jury can not change the *nature* of the obviousness decision. It continues to be a legal issue for the court. Indeed, the role of a trial court should not be significantly different in a patent jury trial from its role in a patent bench trial with respect to legal issues. On appeal, the standard of review applied by an appellate court to factual issues is affected by the different type of trial. Findings of fact by the jury are more difficult to set aside (being reviewed only for reasonableness under the substantial evidence test) than those of a trial judge (to which the clearly erroneous rule applies). But the standard of review of the conclusion of obviousness remains the same — it is a question of law. Thus, it is the duty of the appellate court to be satisfied that the law has been correctly applied to the facts regardless of whether the facts were determined by judge or jury." (footnote omitted) (emphasis in original)

The Petition compares patent cases to negligence cases and concludes that when obviousness is involved, a jury verdict is sacrosanct. Patent cases are not negligence cases. In any event, that analysis ignores summary judgments, directed verdicts and judgments N.O.V. granted in negligence cases. See e.g., *Wilson* v. *Good Humor Corp.*, 757 F.2d 1293 (D.C.Cir. 1985); *Cook* v. *Branick Mfg., Inc.*, 736 F.2d 1442 (11 Cir. 1984); *Carlson* v. *American Safety Equipment Corporation*, 528 F.2d 384 (1 Cir. 1976); *Bruce* v. *Martin-Marietta Corp.*, 544 F.2d 442 (10 Cir. 1976).

The case relied on by Newell, *Schulz* v. *Pennsylvannia R. Co.*, 350 U.S. 523 (1956), involved "disputed questions of fact." There is no such disputed question of fact here.

4. *The Petition's Other Arguments Are Also Unsound*

Newell contends that there are disputed issues of material fact from which inferences favorable to Newell could have been drawn. The Petition, for example, speaks of "failures of others and a long felt need" (P 21). The dissenting opinion also relied on these alleged failures (e.g., A 64a-65a). As Judge Boyle held, and the majority affirmed, there was no proof of such failures after the development of the Corcoran material. As the panel majority also held, to the extent that Newell disputes these findings, "no reasonable jury could resolve the underlying factual dispute on this record other than as stated by the trial judge."

Newell's reference to "the skepticism of at least one other skilled artisan" (P 4) is misleading. The only skepticism was whether the consumer would purchase the product, not whether it was technically viable. As correctly observed by Judge Boyle, "the industry resisted the advance represented by the Corcoran material" for business reasons (A 87a). The only doubt expressed was whether such a shade made business sense. For example, Joanna-Western engineers considered using the vinyl Corcoran material on their telescoping roller well before Ferguson made his shade, and even selected such a roller (JA 463-64). As Judge Boyle noted, they dropped that project because it was not in Joanna-Western's business interest to proceed with it (A 88a). That product would have cut into sales of Joanna-Western's cloth shades in which it had a large investment (A 88a-89a). Breneman, likewise, resisted for business reasons, not because it doubted the product would work. As, Judge Boyle noted, Breneman "believed the product would fail in the marketplace" (A 87a-88a).

Newell's arguments about copying (P 4-5) also miss the mark. Kenney did not copy the Newell shade. The Kenney shade material is not attached to the smaller roller and thus

operates differently from the Newell claimed shade and does not infringe. The panel majority noted specifically that the Kenney shade was different from the patented design (A 5a).

The Petition also repeatedly contends, in what must be the height of wishful thinking, that the panel majority "implicitly" admits that a reasonable jury could have found the '770 patent non-obvious (e.g., P 7). No fair reading of that opinion affords any such conclusion. There is no suggestion, implicit or explicit, in the panel majority opinion that a reasonable jury could have reached any conclusion different from that reached by the District Court or the panel. The contrary is true. Judge Boyle held that no reasonable jury could have found that the '770 patent was valid. After categorizing the undisputed facts, the panel majority affirmed Judge Boyle's decision. Newell's statement (P 7) that the panel did not affirm the District court "in substance" is unwarranted.

Newell's statement that the panel majority "misinterpreted what the inventor was saying about the obviousness of a particular combination" (P 16) is wrong.[10] Ferguson, the patentee, testified that it would have been obvious to put the Corcoran shade material on an adjustable roller (JA 173), and that he was not responsible for the success of the Newell product (JA 177). Whether Ferguson was referring to the Corcoran material or to the production methods as responsible for the success of the Newell shade is irrelevant. Neither one was Ferguson's contribution. In any event, Newell in *ante litem motem* statements, unequivocally attributed the success of its shade to the Corcoran material and Ferguson testified that the Corcoran material was "the heart" of his product (JA 178).

The Petition's contentions about special interrogatories also miss the mark. Neither the District Court's decision nor

[10] Newell's implication that the Corcoran material was "experimental" (P 9) is misleading in the extreme. The Corcoran shade material was commercial. There was no dispute at trial on that issue. The Court of Customs and Patent Appeals relied on the commercial nature of the Corcoran material when it held Corcoran's application for a patent on the combination of that material and a roller not patentable (*supra* at 2).

Newell's appeal involved the propriety of any special interrogatory. The dissenting opinion's litany of hypothetical special interrogatories (A 31a) is simply that — hypothetical. There was no issue about special interrogatories before the Federal Circuit.[11]

The Petition's suggestion (e.g., P 8, 12, 16) that the Federal Circuit has now mandated special interrogatories in patent cases is simply not so. As the Federal Circuit made plain in *Weinar* v. *Rollfoarm Inc.*, 744 F.2d 797, 809 (Fed.Cir. 1984):

> "The foregoing and other considerations reflect the wisdom of continuing to repose the question of submitting interrogatories within the sound discretion of the trial judge who is most familiar with all the courtroom circumstances existing at the time."

Nothing in the panel majority's decision undermines this conclusion in any way.

The Petition also misconstrues the nature of most patent cases by asserting that the scope and content of the prior art are rarely in dispute (P 14). The contrary is true. Most patent cases involve sharp disagreements concerning the teachings of the prior art. In such cases, the jury must resolve these issues. Nothing in the panel majority decision removes this role from the jury. This is a case in which the facts are so clear that, as the panel majority held, no reasonable jury could disagree with Judge Boyle's discussion of those facts.

Thus, Newell's arguments that this is an "ideal" case for the Court to consider undermines its own position. The suggestion that this Court should only take uncomplicated cases is hardly compelling. To the contrary the "uncomplicated" nature of the technology involved here allows this Court to recognize, without further briefing, that there has been no miscarriage of justice in this case. The patent in suit is not valid.

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[11] The comment of the panel majority with respect to special interrogatories and Rule 49, F.R.Civ.P., relied on in the Petition (P 8, 12, 16) was pure dicta. That comment does not raise any issue to be decided by this Court.

## CONCLUSION

The Petition for a writ of certiorari should be denied.

Respectfully submitted,

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